

Appl. No. 09/629,553  
Amdt. Dated 12/31/2004  
Response to Office action dated 12/14/2004

### **REMARKS**

Claims 1-10 and 12-29 are pending. No new matter has been added.

#### ***Disclaimers Relating to Claim Interpretation and Prosecution History Estoppel***

Claims 4, 10, 12, 14, 22 and 25 have been amended, and claim 11 has been canceled, notwithstanding the belief that these claims were allowable. Except as specifically admitted below, no claim elements have been narrowed. Rather, cosmetic amendments have been made to the claims and to broaden them in view of the cited art. Claims 4, 10, 12, 14, 22 and 25 have been amended solely for the purpose of expediting the patent application process, and the amendments were not necessary for patentability.

Any reference herein to "the invention" is intended to refer to the specific claim or claims being addressed herein. The claims of this Application are intended to stand on their own and are not to be read in light of the prosecution history of any related or unrelated patent or patent application. Furthermore, no arguments in any prosecution history relate to any claim in this Application, except for arguments specifically directed to the claim.

#### ***Claim Objections***

The Examiner objected to claims 7 and 22 because of the following informalities:

Claim 7 line 5, the word "not" should be omitted. Claim 22 line 3, there should be a comma placed between "online service" and "the system."

Claims 7 and 22 have been amended per the Examiner's suggestion. Therefore the objections have been overcome.

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***Claim Rejections - 35 USC § 112***

The Examiner rejected claims 10, 15, 16, 22, and 25 under 35 USC § 112, second paragraph as indefinite.

The Examiner asserted that the limitation "the window" in claim 10 has insufficient antecedent basis. Claim 10 has been amended such that "a window" and "the window" are now "a client window" and "the client window." The amendment overcomes the rejection.

The Examiner asserted that the limitation "the client window" in claims 15 and 16 have insufficient antecedent basis. Claims 15 and 16 depend from claim 10. Because claim 10 has been amended to include the limitation "a client window," the rejection has been overcome.

The Examiner asserted that the limitations "the online server" and "the client application" in claim 22 have insufficient antecedent basis. Claim 22 has been amended such that "the user utilizing the online service with a local device" is now "the user utilizing a client application on a local device" and "the local device displays advertisements from the online service" is now "the local device displays advertisements from an online server associated with the online service." The amendment overcomes the rejection.

The Examiner asserted that the limitation "the play list" in claim 25 has insufficient antecedent basis but can be corrected by changing dependency from claim 22 to claim 24. Claim 25 has been rewritten in independent form including the limitations from both claims 22 and 24. The amendment overcomes the rejection.

***Claim Rejections - 35 USC § 103***

The Examiner rejected claims 1-3, 5-10, 12, 13, 15, 16, 22-24, and 26-29 under 35 USC § 103 as obvious from Tazoe et al. (USP 6,626,985) in view of van Hoff et al. (USP 5,959,623). This rejection is respectfully traversed.

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Tazoe is directed to a method of controlling the display screen of a computer (See Tazoe, 2:40-43). When the mouse cursor is located within a window for a predetermined time, the window is considered "active" and the standard content of that window is displayed (See Tazoe, 15:12-24). When the mouse cursor is located outside of a window for a predetermined time, the window is considered "inactive" and the standard content of that window is not displayed (See Tazoe, 15:45-54). In the inactive window, either in the background or the periphery of the active window, an alternate message may be displayed (See Tazoe, 15:54-61, 1:66-2:6).

Van Hoff discloses a "method and apparatus for displaying user selectable advertising information or other user selectable informational images on a host computer." (See van Hoff, 2:8-11) In van Hoff, a special advertising application displays an "Ad Window" concurrently with a browser application displaying a browser window. The user uses the advertising application to configure preferred "Ad lists." "The Ad Window application includes methods 200 and a user established list 210 of preferred advertising lists comprising a plurality of pointers 212-1 through 212-n associated with information image lists which have been selected by the user." (See van Hoff 4:5-9). The heart of van Hoff is that the user selects which ads he wishes to have displayed in the Ad Window.

"To establish a *prima facie* case of obviousness, [. . .] the prior art reference (or references when combined) must teach or suggest all the claim limitations." *MPEP 706.02(j)*.

#### **Claim 1:**

Claim 1 is independent. Claim 1 recites, "the client application establishing a communication channel from the local device to the online server." The Examiner asserted that Tazoe shows this limitation at 8:51-59. Tazoe, at 8:51-59, discloses that a computer is physically connected to the internet through a router and may download software. Tazoe's ability to download software does not teach "the client application establishing a communication channel from the local device to the online server."

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Claim 1 recites,

if the user has not interacted with the local device with respect to the client application for a predetermined amount of time, the client application causing a dialog to be displayed on the output device of the local device, wherein the dialog notifies the user that the user has been inactive with respect to the online service, and wherein a display associated with a resource locator is displayed in the dialog.

The Examiner asserted that Tazoe shows this limitation at 15:47-16:8. Tazoe, at 15:47-16:8, discloses that when a mouse cursor is outside of an application window for a predetermined period of time, the application window is filled with a status of mail or an advertisement. Changing the display of an application window from the application to an advertisement is not causing a dialog to be displayed, wherein the dialog notifies the user that the user has been inactive with respect to the online service.

Because Tazoe in view of van Hoff fails to teach each and every element of claim 1, claim 1 is not obvious from Tazoe in view of van Hoff. Therefore the rejection should be withdrawn and claim 1 should be allowed to issue.

**Claim 10:**

Claim 10 is independent. Claim 10 recites, "the client application removing the client window from the output device of the local device if the user has not interacted with the client window for a predetermined amount of time." The Examiner asserted that Tazoe shows this limitation at 15:54-56. Tazoe, at 15:47-16:8, discloses that when a mouse cursor is outside of an application window for a predetermined period of time, the application window is filled with a status of mail or an advertisement. Filling the application window with alternate content is fundamentally different from removing the window.

Because Tazoe in view of van Hoff fails to teach each and every element of claim 10, claim 10 is not obvious from Tazoe in view of van Hoff. Therefore the rejection should be withdrawn and claim 1 should be allowed to issue.

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**Claim 22:**

Claim 22 is independent. Claim 22 recites,

if it is determined that user has not interacted with the local device with respect to the client application for a predetermined amount of time, display a dialog on the output device of the local device, wherein the dialog notifies the user that the user has been inactive with respect to the online service, and wherein a display associated with a resource locator is displayed in the dialog.

The Examiner asserted that Tazoe, at 15:47-16:8, shows this limitation. Tazoe, at 15:47-16:8, discloses that when a mouse cursor is outside of an application window for a predetermined period of time, the application window is filled with a status of mail or an advertisement. Changing the display of an application window from the application to an advertisement is not causing a dialog to be displayed, wherein the dialog notifies the user that the user has been inactive with respect to the online service.

Because Tazoe in view of van Hoff fails to teach each and every element of claim 22, claim 22 is not obvious from Tazoe in view of van Hoff. Therefore the rejection should be withdrawn and claim 22 should be allowed to issue.

**Claims 2 and 23:**

By virtue of their respective dependence from claims 1 and 22, claims 2 and 23 are patentable over Tazoe in view of van Hoff.

Claims 2 and 23 recite, "wherein the resource locator is associated with an advertisement." The Examiner asserted that Tazoe, at 15:60-66, shows this limitation. Tazoe, at 15:60-66, does disclose that an advertisement may be displayed, however it does not discuss resource locators.

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Because Tazoe in view of van Hoff fails to teach each and every element of claims 2 and 23, claims 2 and 23 are not obvious from Tazoe in view of van Hoff. Therefore the rejection should be withdrawn and claims 2 and 23 should be allowed to issue.

**Claims 3, 13, and 24:**

By virtue of their respective dependence from claims 1, 10, and 22, claims 3, 13, and 24 are patentable over Tazoe in view of van Hoff.

Claims 3, 13, and 24 recite,

wherein the display of at least one advertisement operates in accordance with a first play list, the first play list comprising at least one ad object, each ad object comprising a resource locator for a given advertisement, a resource locator for a click-through associated with the given advertisement, and at least one display attribute for the given advertisement, the first play list further specifying an order in which the advertisements identified in the play list are to be displayed.

The Examiner asserted that van Hoff, at 4:5-21, shows this limitation. Van Hoff, at 4:5-21, discloses methods of displaying a user selected advertisement list of informational images on the display of the client computer. Van Hoff's ad list comprises a list of informational images. Van Hoff's ad list does not include an ad object wherein the ad object comprises "a resource locator for a given advertisement, a resource locator for a click-through associated with the given advertisement, and at least one display attribute for the given advertisement."

Because Tazoe in view of van Hoff fails to teach each and every element of claims 3, 13, and 24, claims 3, 13, and 24 are not obvious from Tazoe in view of van Hoff. Therefore the rejection should be withdrawn and claims 3, 13, and 24 should be allowed to issue.

**Claim 5:**

By virtue of its dependence from claim 1, claim 5 is patentable over Tazoe in view of van Hoff.

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**Claims 6 and 26:**

By virtue of their respective dependence from claims 1 and 22, claims 6 and 26 are patentable over Tazoe in view of van Hoff.

**Claims 7 and 27:**

By virtue of their respective dependence from claims 1 and 22, claims 7 and 27 are patentable over Tazoe in view of van Hoff.

Claims 7 and 27 recite,

wherein the client window includes a plurality of user-selectable icons, each icon being associated with a given function of the client application, and wherein the client application determines that the user has not interacted with the local device with respect to the client application for a predetermined amount of time if the user has not clicked on any of the icons within the predetermined amount of time.

The Examiner asserted that Tazoe, at Fig. 5, setup, help, end, stop, and 16:32-37, shows this limitation. Tazoe's Fig. 5 shows the application program The King of Translation, a machine translation tool for translating text on the internet. Tazoe, at 16:32-37, indicates that the King of Translation application has user-selectable icons for controlling the application program. These sections of Tazoe are unrelated to the limitation "wherein the client application determines that the user has not interacted with the local device with respect to the client application for a predetermined amount of time if the user has not clicked on any of the icons within the predetermined amount of time."

Because Tazoe in view of van Hoff fails to teach each and every element of claims 7 and 27, claims 7 and 27 are not obvious from Tazoe in view of van Hoff. Therefore the rejection should be withdrawn and claims 7 and 27 should be allowed to issue.

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**Claims 8 and 28:**

By virtue of their respective dependence from claims 1 and 22, claims 8 and 28 are patentable over Tazoe in view of van Hoff.

**Claims 9 and 29:**

By virtue of their respective dependence from claims 1 and 22, claims 9 and 29 are patentable over Tazoe in view of van Hoff.

**Claim 12:**

By virtue of its dependence from claim 10, claim 12 is patentable over Tazoe in view of van Hoff.

Claim 12 recites, "after the client window had been removed from display on the local device, the client application re-displaying the client window on the output device of the local device if the user interacts with the browser application." The Examiner asserted that Tazoe, at 15:3-15, shows this limitation. Tazoe, at 15:3-15, discloses that if a mouse cursor is placed within an application window for a predetermined period of time, then the user's focus is on the application. This portion of Tazoe does not disclose that a client window has been removed from the display. Moreover, this portion of Tazoe does not disclose that the client window is re-displayed if the user interacts with the browser application.

Because Tazoe in view of van Hoff fails to teach each and every element of claim 12, claim 12 is not obvious from Tazoe in view of van Hoff. Therefore the rejection should be withdrawn and claim 12 should be allowed to issue.



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**Claim 15:**

By virtue of its dependence from claim 10, claim 15 is patentable over Tazoe in view of van Hoff.

Claim 15 recites, "wherein the client application causes the client window to be displayed on top of the browser window on the output device." The Examiner asserted that Tazoe's Fig. 6 shows this limitation. Tazoe's Fig. 6 shows the application program The King of Translation on the desktop screen. Tazoe's Fig. 6 does not show a client application causing the client window to be displayed on top of the browser window. In fact, Tazoe's Fig. 6 is wholly unrelated to a browser window.

Claim 15 recites, "wherein the client application prevents any other window which might be caused to be displayed on the output device from being displayed on top of the window." The Examiner took Official Notice with regard to this limitation.

Ordinarily, there must be some form of evidence in the record to support an assertion of common knowledge. See *Lee*, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002); *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (holding that general conclusions concerning what is "basic knowledge" or "common sense" to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection). *MPEP 2144.03*.

Because the Examiner has not made a prima facie case of obviousness with regard to "wherein the client application prevents any other window which might be caused to be displayed on the output device from being displayed on top of the window," it follows that the claimed feature does not meet the Official Notice requirement that "facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known." *MPEP 2144.03*.

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Because Tazoe in view of van Hoff fails to teach each and every element of claim 15, claim 15 is not obvious from Tazoe in view of van Hoff. Therefore the rejection should be withdrawn and claim 15 should be allowed to issue.

**Claim 16:**

By virtue of its dependence from claim 15, claim 16 is patentable over Tazoe in view of van Hoff.

***Conclusion***

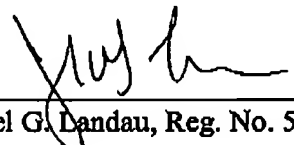
It is submitted, however, that the independent and dependent claims include other significant and substantial recitations which are not disclosed in the cited references. Thus, the claims are also patentable for additional reasons. However, for economy the additional grounds for patentability are not set forth here.

In view of all of the above, it is respectfully submitted that the present application is now in condition for allowance. Reconsideration and reexamination are respectfully requested and allowance at an early date is solicited.

The Examiner is invited to call the undersigned attorney to answer any questions or to discuss steps necessary for placing the application in condition for allowance.

Respectfully submitted,

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